## REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1 and 3-7 are pending. Claims 1 and 6 are amended. Claim 2 was canceled previously. Support for the amendment to Claim 1 can be found in the specification on page 8, lines 19-27 and in Fig. 1, for example. Support for the amendment to Claim 6 is self-evident. Claim 7 is withdrawn. No new matter is added.

Claims 1 and 3-6 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1 and 3-6 were rejected under 35 U.S.C. § 102(b) as anticipated by Shigeta (Japanese Patent Pub. 07/232770, herein "Shigeta"). Claims 1 and 3-6 were rejected under 35 U.S.C. § 102(e) as anticipated by Hollander (U.S. Patent No. 6,431,359, herein "Hollander"). Claims 1 and 3-6 were rejected under 35 U.S.C. § 102(b) as anticipated by Densen (U.S. Patent No. 4,953,779, herein "Densen").

Regarding the rejection of Claims 1 and 3-6 as indefinite, that rejection is respectfully traversed by the present response.

The outstanding Office Action asserted that the phrase "a three-dimensional image is observable when..." in Claim 1 is indefinite because "those phrases have no clean meaning as to how are images on the package can form a three-dimensional image." Claim 6 was rejected for reciting "a figure."

Claim 1 is amended to recite "first and second images configured to be observed as a three-dimensional image via a parallel observation method or via a cross-observation method." Support for this amendment can be found in the specification on page 8 and in Fig. 1, for example. Claim 6 is amended to replace "a figure" with "at least one of first and second images." Accordingly, Applicants respectfully submit that the rejection of Claims 1 and 3-6 as indefinite are overcome.

Regarding the rejection of Claims 1 and 3-6 as anticipated by Shigeta, that rejection is respectfully traversed by the present response.

Amended independent Claim 1 recites, in part:

> ... at least first and second images configured to be observed as a three-dimensional image via a parallel observation method or via a cross-observation method when observed as a pair,
> wherein the first image is disposed on a first surface of at least two surfaces of the merchandise package and the second image is disposed on a second surface thereof, and
> the merchandise package is a parallelepiped.

Accordingly, the first and second images are formed on first and second surfaces of a **parallelepiped merchandise package**.

One benefit of providing the first and second images on a parallelepiped is that the images may be easily disposed on two individual packages, and the packages may be placed next to each other in appropriate alignment inasmuch as parallelepipeds provide surfaces that are easy to align with each other, for example, on a retailer's shelf.

The outstanding Office Action, on page 4, relies on Figs. 1a and 2 of Shigeta for the package recited in independent Claim 1, stating "[t]herefor, the Figure 1(a) or Figure 2 is a container/package and the container is a parallelepiped."

However, Applicants respectfully submit that subject (1) is not a "package" as a person of ordinary skill in the art would understand the term "package." Rather, subject (1) is merely an object to be observed, such as a painting or poster, and reference number (2) refers to a drawing. Neither of these reference numbers (in either of Figs. 1 and 2) refers to a **parallelepiped merchandise package**.

Regarding the cans depicted in Fig. 1 of Shigeta, Applicants respectfully submit that the cans are not **parallelepipeds**. Accordingly, Shigeta fails to disclose all the features of amended independent Claim 1.

Claims 3-6 depend from amended independent Claim 1 and patentably distinguish over Shigeta for at least the same reasons as amended independent Claim 1 does.

Regarding the rejection of Claims 1 and 3-6 as anticipated by Hollander, that rejection is respectfully traversed by the present response.

In the "Response to Arguments" section, the outstanding Office Action states:

> The images of Hollander are inherently capable of forming a three-dimensional image when observed as a pair by the techniques as disclosed by the specification of the instant patent application or by the techniques of Shigeta.[1]

In reference to another of the cited references, the outstanding Office Action further comments on inherency, stating:

> Applicant further argues "for a feature to be inherent, the feature must necessarily be present in the cited reference" on page 7 of the remarks is noted. This is not persuasive because for inherently rejection, the feature does not have to be presented in the specification but the invention is capable of forming the feature. In this case, the images of Densen are inherently capable of forming the feature by the technique as taught by Shigeta.[2]

Accordingly, the outstanding Office Action asserts that for a rejection based on inherency, the claimed feature does not have to be presented in the *specification* but the device disclosed in the cited art must be merely capable of forming the claimed feature.

Applicants respectfully submit that the above-noted standard for inherency applied in the outstanding Office Action is incorrect. Rather, for an inherency rejection, the device cited reference (not just the specification) must **necessarily** disclose the claimed feature. It is insufficient for the device to be capable of operating as or forming the claimed feature. In other words, it must be impossible for the thing described in the reference not to include the cited feature.

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[1] Outstanding Office Action, page 4.
[2] Outstanding Office Action, page 5.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112, In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Moreover:

> to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

Finally, as set forth in MPEP § 2112, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art." (emphasis added). Ex party Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Turning now to the cited reference, Hollander describes a "Multi-View Packaging Material." In Hollander, different images (such as front, side, top, and back views) are disposed on corresponding surfaces of the packaging material. When a person views the package from a different angle, the contents of the packaging material can be viewed according to the particular image associated with that angle. In other words, Hollander disposes a front image on a front surface of a package, a right-side image on a right side of a package, and a back image on a back surface of a package.

None of the images described in Hollander is a three-dimensional image as a person of ordinary skill in the art would understand the term "three-dimensional." Rather, each of the images formed on the different sides of the package described in Hollander is a mere two-dimensional view of a three-dimensional item on a package. **In other words, providing front, side, top, and bottom views of an object is not the same as providing a three-dimensional image of the object.**

The arrangement described in Hollander is not described as configured to form a three-dimensional image when viewed as a pair with another image as a person of ordinary skill in the art would understand the term "three-dimensional." Nor is it true that these images will necessarily form a three-dimensional image. In fact, it is unlikely that any of the images described in Hollander would form a three-dimensional image inasmuch as Hollander is silent regarding this effect. Accordingly, as amended independent Claim 1 recites that the first and second images are configured to be observed as a three-dimensional image when observed as a pair, amended independent Claim 1 and the claims depending therefrom patentably distinguish over Hollander for at least the reasons discussed above.

Regarding the rejection of Claims 1 and 3-6 as anticipated by Densen, that rejection is respectfully traversed by the present response.

Densen merely describes a decorated blank that can be folded so as to form a predetermined design when a box is produced from a flat blank. Densen does not indicate that two images on the folded box, when observed together as a pair, are observable as a **three-dimensional image**. Rather, all of the images disposed on all of the surfaces of the blank described in Densen are mere two-dimensional images configured to be observed as two-dimensional images individually and not configured to be observed as a pair with another image as a three-dimensional image.

The outstanding Office Action asserts that the images on the package described in Densen are "inherently capable of forming a three-dimensional image by becoming a pair."[3] However, Applicants respectfully submit that for a feature to be inherent, the feature must necessarily be present in the cited reference.[4]

In the present case, Densen does not describe that any of its two-dimensional images are configured to be viewed as a pair to form a three-dimensional image, and the outstanding

[3] Outstanding Office Action, page 4.
[4] MPEP § 2112.

Office Action has pointed to no portion of Densen or to evidence in the record in support of the assertion that the two-dimensional images described in Densen inherently form a three-dimensional image. **Not all combinations of two-dimensional images form three-dimensional images when viewed as a pair**. Therefore, as the recited characteristic is not **necessarily** present in all two-dimensional images, the recited characteristic is not necessarily present in the standard two-dimensional images described in Densen. Under the proper legal standard for making a rejection relying on inherency, Densen does not inherently disclose first and second images that form a three-dimensional image. Thus, Applicants respectfully submit that amended independent Claim 1 and the claims depending therefrom patentably distinguish over Densen for at least the above-noted reasons.

Additionally, Applicants respectfully submit that dependent Claim 6 further patentably distinguishes over Densen inasmuch as amended dependent Claim 6 recites:

> wherein at least one of the first and second surfaces is an outside surface, wherein at least one of the first and second images has a point symmetry shape and is disposed on the outside surface in a manner such that a center of the at least one of the first and second images is displaced from a center point of the outside surface, and a three-dimensional image is observable when two of the merchandise packages are juxtaposed in a manner such that one of the two merchandise packages is rotated by 180 degrees relative to the other merchandise package.

Densen merely describes a plurality of images disposed on various sides of a box. Densen does not suggest that one box rotated 180° relative to another box would produce a three-dimensional image when an image disposed on one side of a box is viewed in combination with an image disposed on a side of the other box when the other box is rotated 180° relative to the first box. Accordingly, Applicants respectfully submit that amended dependent Claim 6 further patentably distinguishes over Densen for at least the additional reasons discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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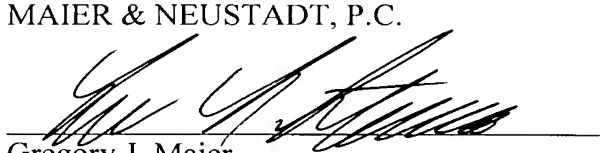

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